

REMARKS / ARGUMENTS

The present application includes pending claims 1-41, all of which have been rejected. Claims 1-41 have been cancelled and new claims 42-71 have been added. The new claims 42-71 are similar in many respects to the original claims 1-41. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1, 3-4, 6-8, 10-12, 15-17, 21-23, 25-26, 28-30, 32-35, and 39-40 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2004/0029619, issued to Liang, et al. (hereinafter, Liang). Claims 2, 13, 14, 19, 20, 24, 36 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Liang, in view of U.S. Patent No. 6,978,121, issued to Lane, et al. (hereinafter, Lane). Claims 5 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Liang. Claims 9 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Liang, in view of U.S. Patent Publication No. 2004/0009751, issued to Michaelis, et al. (hereinafter, Michaelis). Claims 18 and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Liang, in view of U.S. Patent No. 7,003,285, issued to Carter (hereinafter, Carter). The Applicant respectfully traverses these rejections at least based on the following remarks.

REJECTION UNDER 35 U.S.C. § 102

I. Liang Does Not Anticipate Claims 42-71

With regard to the anticipation rejections under 102(e), MPEP 2131 states that “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See *id.* (internal citation omitted).

Without conceding that Liang qualifies as prior art under 35 U.S.C. § 102(e), the Examiner traverses the rejection as follows.

A. New Independent Claims 42 and 57

The Applicant submits that Liang does not disclose or suggest at least the limitation of “in a chip comprising a plurality of wireless transmitter and/or receiver devices, generating two or more priority signals to control prioritization of information between corresponding MAC interfaces for each of said plurality wireless transmitter and/or receiver devices within said chip,” as recited by the Applicant in independent claim 1.

Referring to FIG. 1 of Liang, the Applicant points out that the WLAN function 104 and the BT function 106 are **not implemented in a single chip**. The Applicant submits that claims 42-71 are allowable at least for this reason.

Liang's invention is summarized in the reference as follows:

A first wireless telecommunications function is communicatively coupled to the antenna switching function, as is a second wireless telecommunications function. The device further comprises arbitration function, communicatively coupled to the antenna switching function and the first and second wireless telecommunications functions. **The arbitration function is adapted to control access to the first and second antennas by the first and second wireless telecommunications functions according to a defined prioritization scheme.**

See Liang at ¶ 0010 (emphasis added). In this regard, **Liang's prioritization scheme is only used to arbitrate access by the WLAN function 104 and the BT function 106 to the first and second antennas (112 and 114).** Liang, at the above citation and throughout its disclosure, specifically clarifies that arbitration is used for controlling the antenna interface to share antenna access, resolve access to the antennas, arbitrate antenna access, granting access to antenna, etc. Liang's prioritization scheme is not used to control prioritization of information between corresponding MAC interfaces. In fact, Liang is silent and does not disclose any MAC interfaces, or any processing with regard to MAC interfaces.

Furthermore, the Applicant submits that Liang does not disclose or suggest at least the limitation of “configuring one or more of said corresponding MAC interface devices via said generated two or more priority control signals,” as recited by the Applicant in independent claim 42. As already explained above, Liang does not disclose any processing with regard to MAC interfaces, including configuring such MAC interfaces via generated priority control signals.

Accordingly, independent claim 42 is not anticipated by Liang and is allowable. Independent claim 57 is similar in many respects to the method disclosed in independent claim 42. Therefore, the Applicant submits that independent claim 57 is also allowable over the references cited in the Final Office Action at least for the reasons stated above with regard to claim 42.

B. Dependent Claims 43-56 and 58-71

Based on at least the foregoing, the Applicant believes independent claims 42 and 57 are not anticipated by Liang and requests that the rejection be withdrawn. Additionally, claims 43-56 and 58-71 depend from independent claims 42 and 57 and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 42-71.

II. INHERENCY

The Final Office Action states the following:

Liang has disclosed a "plurality of available priority indications" because once a first priority has been assigned, **inherently a second priority (either higher or lower than the first priority) has been assigned**. The examiner welcomes any example/explanation where this would not be true.

See the Final Office Action at page 4. Initially, regardless of whether this statement is true or not, the Applicant notes that it appears that Applicant's claims are being rejected based on inherency.

The Applicant respectfully disagrees with the above assertion by the Examiner that "once a first priority has been assigned, inherently a second priority (either higher or lower than the first priority) has been assigned." For example, there may be instances when the same priority may be assigned for both the WLAN and the BT transmitter. In such instance, both transmitters may proceed and subsequent determination may be made whether one or the other transmission deteriorates (the Examiner is further referred to the present specification where such examples are illustrated and discussed). Therefore, it is not true that "once a first priority has been assigned, inherently a second priority (either higher or lower than the first priority) has been assigned."

The Applicant submits that a rejection based on inherency must include a statement of the rationale or evidence tending to show inherency. See Manual of Patent Examining Procedure at § 2112. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” See *id. citing In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. **Inherency, however, may not be established by probabilities or possibilities.** The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The Applicant respectfully submits that neither Liang itself nor the Final Office Action “make[s] clear that the missing descriptive matter,” said to be inherent “is necessarily present in” Liang.

A rejection based on inherency must be based on factual or technical reasoning:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

The Applicant respectfully submits that the Final Office Action does not contain a basis in fact and/or technical reasoning to support the rejection based on inherency. Instead, as recited above, the Applicant's claims stand rejected based on a conclusory statement of inherency, rather than upon a "basis in fact and/or technical reasoning." Accordingly, the Applicant respectfully submits that, absent a "basis in fact and/or technical reasoning" for the rejection of record, that rejection should be reconsidered and withdrawn.

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 42-71 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Date: 26-JUN-2008

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